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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/619,220 07/19/00 GARBER

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EXAMINER

MULLEN, T

ART UNIT

PAPER NUMBER

2632

DATE MAILED:

02/26/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/619220

Applicant(s)

Garber et al.

Examiner

Mullen

Group Art Unit

2632

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 1/12/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1-1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
- Of the above claim(s) 1-25 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 26-36 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The proposed drawing correction, filed on 7/19/00 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 3, 4, 6, 11
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. Applicant's election without traverse of group III, claims 26-36 in Paper No. 10 filed 1/12/01 is acknowledged.
2. Regarding the "Incorporation by Reference" and "Related Applications" paragraphs at the top of page 1 of the specification, it is unclear if applicant intended for the same applications to be listed in each paragraph, in which case it is noted that Ser. No. 09/368,826 is listed in the second paragraph but not the first. The final status (patented with pat. no., or abandoned) of each of the applications mentioned should be inserted in the appropriate place.
3. The proposed drawing changes are approved.
4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Errors noted by the examiner include:

page 12, line 4, it appears "of" should be --or--; and

page 13, line 15, "NY" should be --NJ-- (see the change previously made on page 6, line 14).
5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following aspects of a "hand-held RFID device" must be shown or the feature(s) canceled from the claim(s):
  - 1) the combining of a computer and RFID reader (along with an antenna and a display) into an "integrated unit" (claim 26);
  - 2) the data transfer system being a "cabled...connection" (claim 30) or "wireless" (claim 31);
  - 3) the computer being a "detachable hand-held computer" (claim 33);
  - 4) the "integral" and "separate" power sources (claims 32 and 34, respectively); and
  - 5) the "information input system" (claim 36).

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No new matter should be entered.

6. Claims 27-31 and 36 are objected to under 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On line 2 in each of claims 27, 28 and 36, “(d)” should be --(e)-- (note that there is already an element (d) in claim 26).

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There is no cohesive teaching in the disclosure (specification and drawings) of the “integrated” hand-held RFID device recited in the claims. In particular, the specification fails to teach how the hand-held RFID reader shown in Figs. 13-14 is to be combined with a “computer” (possibly element 108 in Fig. 4) as an “integrated” hand-held unit, nor is there a discussion of any type of structure (i.e. housing) for forming the “integrated” unit and providing support for the presumably external components of the device (e.g. antenna, display) recited in the claims. (It is noted that there is an “antenna” 104 in the block diagram of Fig. 4, and that Figs. 13-14 feature a reader housing having an unlabeled “display”.) Further, even assuming that the computer and reader are combinable into an “integrated” hand-held unit, there is also no showing or discussion as to how the computer is then made “detachable” from the integrated unit. Note that the paragraph overlapping pages 22-23 of the specification--to the extent that it relates to an “integrated” device--makes no reference to any drawing figure where various features of an

“integrated” RFID device might be shown.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 26, it is unclear what relationship, if any, exists between the “RFID tag” on line 3 and the “RFID elements” on line 5, i.e. are these the same or different types of elements in the context of the disclosure.

In claim 36, it is unclear what is meant by providing information to the RFID device by “interrogation”, i.e. does this imply that the RFID device is interrogating other sources for information, that the RFID device is being interrogated by other sources which then provide information back to the RFID device, that the interrogation takes place between two other entities which then pass the results along to the RFID device, etc.

9. Claims 26-36 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.

Among the art cited by applicant, it is noted that Bowers et al (US 5,963,134) discloses a portable RFID scanner 42 and portable computer 122 usable together (Fig. 9 and col. 15); however, Bowers et al fails to teach that these elements may be combined into an “integrated unit”.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Quartararo discloses a portable RFID reader (702 in Fig. 7).

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Mullen whose telephone number is (703) 305-4382. The examiner can normally be reached on Mon-Thur from 6:30AM to 4:00PM. The examiner can also be reached on alternate Fridays (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass, can be reached on (703) 305-4717.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051 (for formal communications intended for entry)

**Or:**

(703) 308-6743 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

T. Mullen  
February 23, 2001

  
THOMAS MULLEN  
PRIMARY EXAMINER